

Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

REMARKS**BEST AVAILABLE COPY**

In the Office Action under reply, the pending claims have been rejected as follows:

1. Under 35 U.S.C. §102(b) as anticipated by EP 956855 (claims 1, 2, and 6-10);
2. Under 35 U.S.C. §103(a) as obvious in view of EP 956855 (claim 3);
3. Under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement (claims 6, 7, 9-13, 26, 27, 29-35, and 37-47); and
4. Under the judicially created doctrine of obviousness-type double patenting over claims 37 et al. of co-pending application 10/947,708 (claims 7 and 8).

The Examiner has additionally objected to the Abstract but has indicated that the subject matter of claims 4-6, 14-25, 28, and 36 would be allowable if the claims were rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In the present amendment, claims 48-55 have been canceled and claims 1, 6-9, 26-29, and 34-37 have been amended. Thus, claims 1-47 are pending in the application. The Examiner's rejections and objections are addressed, in part, by the above-amendments and are otherwise traversed by the arguments presented below.

THE RESTRICTION REQUIREMENT

The Examiner required restriction of the claims as filed into three groups:

- I. Claims 1-47, drawn to methods of synthesis;
- II. Claims 48 and 49, drawn to imino pyrimidines; and
- III. Claims 50-55, drawn to pyrimidine amides.

Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

While the Examiner did not include claim 50 with the Group III claims, Applicants assume that the Examiner intended to place claim 50 within Group III. If this is not the case, Applicant request clarification of the issue.

In a telephone conversation with the Examiner on September 9, 2005, Applicants made a provisional election of the claims of Group I without traverse. Applicants hereby confirm the election without traverse.

THE AMENDMENTS TO THE SPECIFICATION

The Abstract has been amended to reflect the cyclization step involved in claimed methods. Support for this amendment can be found in claim 1. No new matter has been added.

THE AMENDMENTS TO THE CLAIMS

Claims 1 has been amended to specify that X is optionally substituted heteroarylene.

Claims 6, 26, and 34 have been amended to clarify that the compound of the depicted formula is contacted with a compound of the formula $Z-Y-X-CO_2H$ in the presence of a carbodiimide or with a compound of the formula $Z-Y-X-C(O)Hal$. Support for this amendment is found in claims as originally filed and on page 2, line 5, to page 3, line 2 of the specification. Claims 7-9, 27-29, and 33-37 have been amended to reflect the amendments to claims 6, 26, and 34.

Claims 48-55 have been cancelled in accordance with the Examiner's requirement for restriction. Cancellation of these claims is without prejudice, without intent to abandon any previously claimed subject matter, and without intent to acquiesce in any rejection of record.

Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

No new matter has been added.

THE REJECTIONS OVER EP 956588:

The Examiner has rejected claims 1, 2, and 6-10 as anticipated by EP 956855 and claim 3 as obvious in view of the reference. The Examiner specifically states that as the reference discloses methods of making compounds analogous to the compounds of the present claims wherein X is arylene, i.e., phenyl.

As independent claim 1 has been amended to limit the X substituent to heteroarylene moieties, the methods and compounds disclosed in EP 956855 neither anticipate nor obviate the presently pending claims. This fact has been tacitly acknowledged by the Examiner in his inclusion of only claims 1-3 and 6-10 in the rejections over EP 956855.

Reconsideration and withdrawal of the rejection is in order and is accordingly requested.

THE REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH,

The Examiner has rejected claims 6, 7, 9-13, 26, 27, 29-35, and 37-47 as failing to comply with the written description requirement. The Examiner specifically references the necessity of a carbodiimide during the reaction. As the claims have been amended to clarify that the compound of the depicted formula is contacted with a compound of the formula Z-Y-X-CO₂H in the presence of a carbodiimide or with a compound of the formula Z-Y-X-C(O)Hal; withdrawal of the rejection is respectfully requested.

Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

**THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION OVER U. S. PATENT
APPLICATION SERIAL NO. 10/947,708**

The Examiner has provisionally rejected claims 7 and 8 under the judicially created doctrine on obviousness-type double patenting over claims 37 et al. of copending U. S. Patent Application Serial No. 10/947,708 (the '708 application) , which is a divisional of the parent application to the present C-I-P application..

In response to the obviousness-type double patenting issue raised by the Examiner, applicants are submitting a Terminal Disclaimer with the present communication, disclaiming the terminal portion of any patent issuing on the present continuing application that would extend beyond the term of any patent issuing on copending U. S. Patent Application Serial No. 10/947,708. Submission of this Terminal Disclaimer is not intended as acquiescence in the double patenting rejection, but is solely for the purpose of expediting prosecution.

Reconsideration and withdrawal of the rejection are accordingly in order and are respectfully requested.

THE OBJECTION TO THE SPECIFICATION

The Examiner objected to the Abstract indicating that it did not recite what the claimed process consisted of. In response, Applicants have amended the Abstract to indicate that the process involves the cyclization of a compound of formula (3). Withdrawal of the objections to the specification is requested.

Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

CONCLUSION

For the foregoing reasons, Applicants submit that the claims are in condition for allowance. A Notice of Allowance is requested, and a prompt mailing thereof would be much appreciated.

Should the Examiner have any questions, he is invited to contact the undersigned attorney at (650) 384-8755.

Respectfully submitted,

Date: 2/21/06 By: J. Elin Hartrum
J. Elin Hartrum
Reg. No. 43,663
Customer No. 27716

CV Therapeutics, Inc.
3172 Porter Drive
Palo Alto, CA 94304
Phone: (650) 384-8755
Fax: (650) 475-0359

S:\LEGAL\CVT\Patent\Docs\01-0163 (6883)\01-163-CIP2\Resp to 12-5-05 OA\2.doc

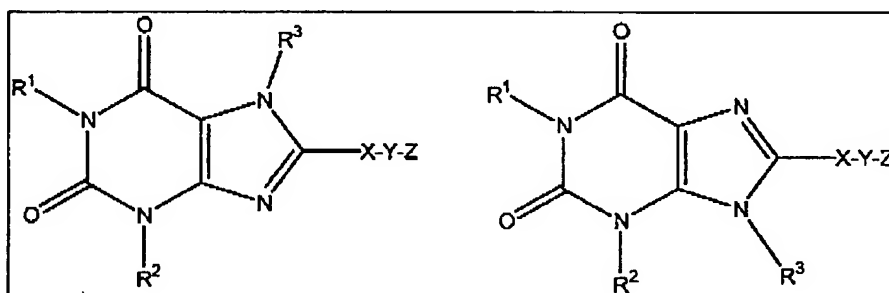
Response to December 5, 2005 Office Action
Serial No. 10/719,102
CVT No. 01-0163-CIP2

APPENDIX A

MARKED UP SPECIFICATION INDICATING AMENDMENTS MADE HEREIN

ABSTRACT OF THE DISCLOSURE

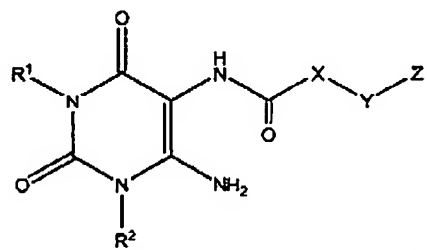
Disclosed are processes for the synthesis of novel compounds that are A_{2B} adenosine receptor antagonists, ~~useful for treating various disease states, including asthma and diarrhea~~ having the structure of Formula I or Formula II:



Formula I

Formula II

by cyclizing a compound of the formula (3):



(3)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.